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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>October 21, 2008</u></p> <p>Signature <u>[Signature]</u></p> <p>Typed or printed name <u>Peter D. Meyer</u></p>		Application Number	Filed
		10/811,160	March 26, 2004
		First Named Inventor	
		Bilskie	
Art Unit		Examiner	
3724		K. E. Peterson	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>47,792</u></p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

[Signature]
Signature
Peter D. Meyer
Typed or printed name
513.983.9084
Telephone number
October 20, 2008
Date

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/811,160
Applicant(s) : Bilskie, et al.
Filed : March 26, 2004
Title : AN APPARATUS FOR SLABBING A
: ROLL OF MATERIAL
TC/A.U. : 3724
Examiner : K. E. Peterson
Conf. No. : 1981
Docket No. : 9596
Customer No. : 27752

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY REMARKS

In response to the Final Office Action dated July 31, 2008, Applicants respectfully file herewith a Notice of Appeal and request review of the present Application before filing an Appeal Brief.

RELATED APPEALS

There are no related appeals known to Applicants' undersigned legal representative which will directly affect, or be directly affected by or having a bearing on, the Board's Decision in any filed appeal.

STATUS OF THE CLAIMS

Claims 1-20 remain pending.

1. Claims 1, 3-7, 9, 11-14, 16, and 18-19 remain finally rejected under 35 U.S.C. §103(a) over *McCay, et al.*, U.S. Patent No. 4,506,575, in view of *Esping, et al.*, U.S. Patent No. 6,761,098.

2. Claims 1, 3-5, 9, 11-12, and 16 remain finally rejected under 35 U.S.C. §103(a) over *Pyron, et al.*, U.S. Patent No. 5,759,350 in view of *Pienta*, U.S. Patent No. 5,308,217.

3. Claims 1, 3-7, 9, 11-14, 16, and 18-19 remain finally rejected under 35 U.S.C. §103(a) over *Pyron* in view of *Pienta* and further in view of *McCay*.

GROUND OF REJECTION FOR REVIEW

Applicants respectfully submit that Claims 1-20 of the instant Application are patentable over any combination of the *McCay*, *Esping*, *Pyron*, or *Pienta* references, alone or in combination.

Rejection under 35 U.S.C. 103(a) over *McCay, et al.*, U.S. Patent No. 4,506,575 in view of *Esping, et al.*, U.S. Patent No. 6,761,098

Claims 1, 3-7, 9, 11-14, 16, and 18-19 remain finally rejected under 35 U.S.C. §103(a) over *McCay, et al.*, U.S. Patent No. 4,506,575, in view of *Esping, et al.*, U.S. Patent No. 6,761,098. This rejection is respectfully traversed.

Applicants respectfully submit that the Office Action fails to set forth a *prima facie* case of obviousness in accordance with M.P.E.P. §2143. In order to sustain a rejection under U.S.C. §103(a), each element of the claimed invention must be taught, disclosed, or suggested by the cited references, alone or in combination. “[Section 103] requires assessment of the invention as a whole. . . . This ‘as a whole’ assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combine them in the claimed matter. . . .” *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332 (Fed. Cir. 2005) “The objective evidence of unobviousness is not evaluated for its

‘separate knockdown ability’ against the ‘stone wall’ of the *prima facie* case . . . but is considered together with all other evidence, in determining whether the invention as a whole would have been obvious to a person of ordinary skill in the field on the invention.” *Id.* “We recognize that ‘the [obviousness] analysis’ need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *See KSR Int’l. Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007); *see also*, BPAI Appeal 2008-1092, p. 6. “However, *KSR* also teaches that an invention ‘and composed of several elements’ is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *See Id.* (Citing *KSR* at 1741) “There must be ‘a reason’ that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *See Id.*

The *McCay* reference goes into explicit detail describing the cantilevered core support. This detail includes an intricate description of a means for securing the core to the cantilevered support (1:44-48). In a nutshell, this additional structure includes a roll stop pin 19 provided to the tube 18 to limit the movement of the core with respect to the tube 18 and position it correctly. (3:43-46) The cam handle 70 is rotated to the crank position shown in FIG. 3 and the camshaft is rotated thereby rotating the cams 60 and lifting the pins 61 to the opening 62 in the tube 18. (3:46-49) This lifts the locking plate 17 inside the core which is placed on the machine to engage the inner surface of the core. (3:49-51) The specification also states that appropriate means such as a ratchet means or pawl and detent means may be utilized to hold the crank handle 70 or the crank shaft 50 in a locked position. (3:51-54) In practice, the camshaft 50 may have a sufficiently tight fit in the sleeves 51 and 55 so that such additional locking means may not be necessary. (3:54-57) Ostensibly, this additional apparatus is provided within the cantilevered tube to prevent a core so disposed thereupon from sliding or rotating, thereby protecting the fiberboard core during the slabbing process.

It can be clearly seen that the additional apparatus required within the cantilevered tube is both an integral and a necessary part of the disclosed invention. Merely inserting the side supports 7 and 8 of the *Esping* reference to lift the core cannot be considered an easily provided substitution. In fact, it is inconceivable as to how the *Esping* reference can be combined with, or in fact substituted for, the *McCay* apparatus. There clearly is no

motivation within either the *McCay* or *Esping* references to provide for the substitution of an *Esping*-like device into the *McCay* slabbing apparatus having the core holding mechanism. To this end, Applicants agree with the Examiner that there is no such motivation “which is something that *McCay* currently lacks.” (July 31, 1008 Office Action, p. 5, Para. 5)

Respectfully, it appears to Applicants that the Examiner is completely obviating the teaching, suggestion, or motivation test provided by the Federal Circuit. It is abundantly clear that the *McCay* reference goes an exceptionally long way to require that the cantilevered tube is a necessary part of the disclosed invention. This is because it is critical that the core remain in a fixed position with respect to the drive unit and carriage device. (3:51-66) The side supports of the *Esping* reference do nothing to fix the core with respect to the carriage of the *McCay* reference. Likewise, for the reasons stated previously, feeding cores onto the cantilevered tube of the *McCay* reference is not the same as providing cores to an apparatus such as that disclosed by *Esping*. Utilization of the side supports of the *Esping* reference to position a core onto the *McCay* cantilevered tube 18 would likely provide a catastrophic drop onto the floor or other supporting structure of the roll to be slabbed upon removal of one or more of the side supports.

Thus, it should be abundantly clear that the *McCay* reference, in view of the *Esping* reference, does not and cannot teach, disclose, or even provide a modicum of a suggestion to each and every element of Applicants’ claimed invention as required by the Court in *KSR*. In particular, the *McCay* and *Esping* references, alone or in combination, do not disclose or suggest Applicants’ claimed apparatus for slabbing a roll. Accordingly, the rejection of the instant claims under 35 U.S.C. §103(a) over the *McCay* and *Esping* references should be withdrawn.

Rejection under 35 U.S.C. 103(a) over Pyron, et al., U.S. Patent No. 5,759,350 in view of Pienta, U.S. Patent No. 5,308,217 and rejection under 35 U.S.C. 103(a) over Pyron, et al., U.S. Patent No. 5,759,350 in view of Pienta, U.S. Patent No. 5,308,217 and further in view of McCay, U.S. Patent No. 4,506,575

Claims 1, 3-5, 9, 11-12, and 16 have been finally rejected under 35 U.S.C. 103(a) over Pyron, et al., U.S. Patent No. 5,759,350, in view of Pienta, U.S. Patent No. 5,308,217. Additionally, Claims 1, 3-7, 9, 11-14, 16, and 18-19 have been finally rejected under 35

U.S.C. 103(a) over Pyron in view of Pienta and further in view of McCay, U.S. Patent No. 4,506,575. These rejections are respectfully traversed. For the sake of brevity, the separate rejections of the affected claims are addressed together since the references utilized by the Examiner are used in a similar combination.

Applicants respectfully submit that the Office Action has failed to set forth a *prima facie* case of obviousness in accordance with M.P.E.P. §2143. Specifically, the Office Action has failed to provide evidence as to where the *Pyron*, *Pienta*, and/or *McCay* references teach, disclose, or suggest Applicants' claimed invention. For example, the *Pyron* reference discloses that the spool 15 of unwanted paper 20 is mounted via step 35 on a pair of spaced apart rails 37. (5:41-43) This presumes that a bar, pipe, or other object must be inserted into the core of the spool 15 and then disposed between two spaced apart rails 37, as shown in Fig. 4 of the *Pyron* reference. This is not what Applicants claim as their invention. It is clearly stated in Claim 1 that Applicants' transport element comprises **a pair** of roll engaging elements capable of penetrating engagement of the core. A singular bar, as provided by the *Pyron* reference, does not constitute a pair of roll engaging elements as required by Applicants' claim. Further, the spaced apart rails 37 are fixed in position and are incapable of movement relative to the core. Therefore, it stands to reason that the roll engaging portions of the *Pienta* and *McCay* references cannot be used in concert with a fixed device. Further, the cantilevered tube disclosed by the *McCay* reference does nothing to repair the deficiencies clearly present in both the *Pyron* and *Pienta* references.

Since it is evident that the *Pyron* reference requires a singular insert, it is difficult to understand how the roll chucking apparatus, such as that disclosed by *Pienta* or the *McCay* apparatus, can be used in junction therewith. The *Pienta* reference requires movement of each of the chucking devices and does not provide for the disposition of the chuck and core apparatus onto the fixably spaced supports 37 present in the *Pyron* reference. Further, insertion of a bar into the core or spool of a roll to be slabbed, as is required by the *Pyron* reference, would necessarily obstruct the resulting core access points so necessary for the *Pienta* reference. If the core holes are obstructed, one must ask how the roll chucks of the *Pienta* reference can access the internal portion of the core so necessary for operation of that apparatus. This ostensibly odd and incompatible collection of parts are clearly not what Applicants claim as their invention.

Further, if one were to assume, *arguendo*, that the core 15 of the *Pyron* reference having the unwanted paper 20 disposed thereon is directly positioned upon the spaced apart rails 37, one of skill in the art is likely to understand the removal of the unwanted paper 20 could not be possible. This is because direct positioning of the spool 15 of unwanted paper 20 upon the spaced apart rails 37 would necessarily dispose a significant amount of the unwanted paper 20 between the spool and the spaced apart rail 37. This would clearly render the *Pyron* apparatus inoperable. In other words, it is difficult to see how elements that ostensibly internally engage a spool of unwanted paper, such as those envisioned by the *Pienta* and *McCay* references, could be fashioned to operate with the *Pyron* reference. Again, the Examiner has failed to provide any clear or particular suggestion of combinability with any of the references cited that would render Applicants' instant claims obvious. There clearly is no motivation to combine the teachings of the *Pyron*, *Pienta* and *McCay* references to render the instant invention obvious. Applicants respectfully believe that the *Pyron* reference, alone or in combination with any of the *Pienta* or *McCay* references, does not, and cannot, teach, disclose, or provide even a modicum of suggestion for each and every element of Applicants' claimed invention. In particular, the combination of the *Pyron*, *Pienta* and *McCay* references cannot be construed in any reasonable way to teach, disclose, or even provide a modicum of a suggestion for Applicants' claimed apparatus for a slabbing roll. Accordingly, the instant rejection of the claims under 35 U.S.C. §103(a) over the *Pyron*, *Pienta* and *McCay* references should be summarily withdrawn.

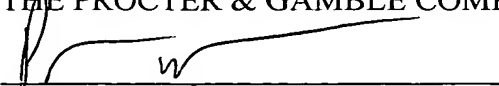
CONCLUSION

In view of the foregoing, allowance of instant Claims 1-20 is respectfully requested. The Examiner is respectfully invited to telephone Applicants' attorney at the number listed below with any questions or comments.

If any additional charges are due, the Examiner is hereby authorized to deduct such charge from Deposit Account No. 16-2480 in the name of The Procter & Gamble Company.

Respectfully submitted,
THE PROCTER & GAMBLE COMPANY

By:


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